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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,392	05/04/2005	Karl-Heinz Schwonke	Q82965	5710
23373 7590 07/12/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER LONEY, DONALD J				
ART UNIT		PAPER NUMBER		
1783				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/509,392

Applicant(s)

SCHWONKE ET AL.

Examiner

Donald Loney

Art Unit

1783

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: English Abstract of JP '899

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 6, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Balmer et al (5102716).

Balmer et al discloses a flooring material comprising an embossed base layer 4 and a clear PVC layer 8 there over wherein the embossed pattern 6 formed in the base is transferred 10 to the underside of the cover layer and wherein the cover layer has a smooth, and planar, top surface (i.e. the embossments are not in the surface of the cover layer extending away from the embossed base layer). Refer to figure 1 along with column 6, lines 12-16 and claim 1. With regards to claims 2 and 3 drawn to process limitations in a product claim, it must be emphasized that it is the patentability of the product that is in issue and not the patentability of the process steps employed to prepare the product. See MPEP section 2113. With regards to claims 6-8, the layer(s) are all what can be considered film(s) and the base can be two layers 2 and 4. With regards to the temperature being higher on the side of the cover layer during lamination as amended in claim 1, it must be emphasized that it is the patentability of the product that is in issue and not the patentability of the process steps employed to prepare the

product. See MPEP section 2113. The alternative use of the term "or" in line 7, does not positively recite the cover layer has a softening point lower than the base layer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 17, 22, 24, 27 and 29 are rejected under 35 U.S.C. 102(b) as being unpatentable over Balmer et al (5102716) in view of either Drittenbass (3126307) or JP 05-104899 (English abstract included).

Balmer et al discloses a flooring material comprising an embossed base layer 4 and a clear PVC layer 8 there over wherein the embossed pattern 6 formed in the base is transferred 10 to the underside of the cover layer and wherein the cover layer has a smooth, and planar, top surface (i.e. the embossments are not in the surface of the cover layer extending away from the embossed base layer). Refer to figure 1 along with column 6, lines 12-16 and claim 1. Balmer does fail to specifically disclose that the transparent cover layer has a softening point lower than the base, or, the temperature is higher on the cover layer side during lamination.

Drittenbass discloses it is known to include plasticizers in a PVC layer in order to provide a softening point lower than the material to which it is to be welded (i.e. attached thereto) to. See column 2, lines 26-38. JP '899 also discloses a top resin layer 2, over a base layer 1, containing a softening temperature lower than the base in order to prevent warpage of the article when forming thereof. See the English abstract.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Balmer et al to form the top PVC layer of a softening temperature lower than the base, as taught by Drittenbass and JP '899, in order to prevent warpage of the article when forming thereof. With regards to claims 22-24, the layer(s) are all what can be considered film(s) and the base can be two layers 2 and 4

as shown in Balmer et al. With regards to claims 27 and 29, the process uses rollers with heat and/or pressure (see column 7, lines 58-68) in Balmer et al.

7. Claims 4, 5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balmer et al in view of either Wiley et al (4409280) or Martin et al (5773127).

The primary reference teaches the invention substantially as recited except for the additional and/ or multiple layer(s). See the 35 U.S.C. 102 rejection above.

Both Wiley et al and Martin et al disclose a base which is embossed and a cover layer there over which has the embossed pattern transferred to the cover layer. See figure 3 in Wiley et al showing base layer 3" and PVC cover layer 5 and figure 5 in Martin et al showing base layer 13 and clear PVC layer(s) 21 and 27 thereon.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Balmer et al to form the layer(s) of multiple layers, as taught by Wiley et al and Martin et al, since this would merely involve duplicating and/or providing additional layers to the laminate. With regards to claims 4 and 5, wherein there is another layer between the base and cover layer. See layer 21 and 27 in Wiley et al and layers 3' and 5 in Martin et al. With regards to claim 7, the base is formed of more than two films as shown in the figures. With regards to claims 12 and 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the embossments of the recited profile dimensions since this would merely involve a change in size and/or shape which is generally within ordinary skill in the art. See MPEP 2144.04IV.

8. Claims 18-21, 23, 25, 26, 28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balmer et al (5102716) in view of either Drittenbass (3126307) or JP 05-104899 (English abstract included) as applied to claims 17, 22-24, 27 and 29 above, and further in view of either Wiley et al (4409280) or Martin et al (5773127).

The combination of the primary reference teaches the invention substantially as recited except for the additional and/ or multiple layer(s). See the 35 U.S.C. 103 rejection above.

Both Wiley et al and Martin et al disclose a base which is embossed and a cover layer there over which has the embossed pattern transferred to the cover layer. See figure 3 in Wiley et al showing base layer 3" and PVC cover layer 5 and figure 5 in Martin et al showing base layer 13 and clear PVC layer(s) 21 and 27 thereon.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Balmer et al to form the layer(s) of multiple layers, as taught by Wiley et al and Martin et al, since this would merely involve duplicating and/or providing additional layers to the laminate. Regarding claims 18 and 19, printing is shown between the layers in both Wiley et al and Martin et al. With regards to claims 20 and 21, wherein there is another layer between the base and cover layer. See layer 21 and 27 in Wiley et al and layers 3' and 5 in Martin et al. With regards to claim 23, the base is formed of more than two films as shown in the figures. With regards to claim 26, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the embossments of the recited profile dimensions since

this would merely involve a change in size and/or shape which is generally within ordinary skill in the art. See MPEP 2144.04IV.

Response to Arguments

9. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection. The applicant does argue that Balmer fails to disclose the cover having a softening point lower than the base, however, as indicated above the alternative use of the term "or" in line 7, does not positively recite the cover layer has a softening point lower than the base layer.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1783

DJL;D.Loney
07/05/10